



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,936	08/09/2001	Elliot Katzman	MTM-00101	4941

7590

12/14/2004

Patent Group  
Hutchins, Wheeler & Dittmar  
101 Federal Street  
Boston, MA 02110

EXAMINER
----------

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/925,936

**Applicant(s)**

KATZMAN ET AL.

**Examiner**

Marissa Thein

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

The drawings filed on December 31, 2001 are acceptable.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites technological arts in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to

Art Unit: 3627

breathe life and meaning into the preamble. For example claim 1, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "executed in a computer system". The recitation "determining member profile information....."; "determining vendor profile....."; determining, by said vendor,....."; "selecting said at least one member...."; "automatically determining..."; and "automatically sending...." have no structural or functional interrelationship with these method steps, which could all be performed manually by a person. Therefore, the claim is directed towards non-statutory subject matter. The other claims above are similarly rejected. To overcome this rejection the Examiner recommends the Applicant to amend the claims to better clarify which of the steps are being performed within the technological arts, such as – determining member profile information via computer network associated with the at least one member.....--.

Claims 8-14 are rejected under 35 U.S.C. 101 because it fails to recite computer executable instructions. The claims are directed to computer program product. The claims fail to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3627

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 7-10, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,141,653 to Conklin et al.**

Regarding claims 1 and 8, Conklin discloses a method and a computer program product comprising:

- determining member profile information (buyer's propose orders) associated with at least one member, the member profile information including one of schedule information and member activity information (the propose orders processes can be based on catalog prices or desired price and other terms, special orders for samples or small quantities, and can include information about the buyer; col. 19, lines 61-66);
- determining vendor (seller) profile information associated with a vendor (a registered seller in the community to create a seller website within the community on which to include the seller's marketing and product information, along with pricing, terms, service and so on, col. 19, lines 18-22);
- determining, by said vendor, a predetermined condition and associated action to be taken in response to an occurrence of the predetermined condition (seller can evaluate orders and other inquires and respond to them, col. 19, lines 29-31);

- selecting the at least one member in accordance with at least one of the predetermined condition and an occurrence of the predetermine condition (col. 19, lines 31-37);
- automatically determining a preferred mode of communication of the at least one member (allows seller to follow the activity by e-mail or browser or similar means, col. 19, lines 34-36); and
- automatically sending a communication in accordance with the associated action to the member using the preferred mode of communication, the communication being customized in accordance with the one of the scheduling information and the member activity information (col. 19, lines 34-37).

Regarding claims 2-3, 7, 9-10, and 14, Conklin discloses demographic data (collecting their demographics, col. 19, lines 10-12); the member (buyer) profile is stored in a first database (Figure 1k, ref. no. 08grpb) and the member profile information is obtained using a portion of the vendor (seller) profile information and other information and other information from a second different database (Figure 1k, 08grpa); and privacy policy access to relevant information by each type of community member (buyer, seller) is protected by password security and access levels, col. 20, lines 1-4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,653 to Conklin et al. in view of U.S. Patent No. 5,970,475 to Barnes et al.**

Regarding claims 4-6 and 11-13, Conklin substantially discloses the claimed invention. Specifically, Conklin discloses the members and organizations (participants) and the wherein the communication is one of a customized proposed action, customized information, and customized request (negotiations). However, Conklin fails to explicitly teach the plurality of members and organization being in a hierarchy of at least two levels. Furthermore, Conklin does not explicitly teach a first member at a first level is one associated with at least one organization, and a second member at the second level is associated with the first member and at least one organization. Conklin discloses a system that provides multiple levels of privacy and access for each individual company, so that the records of transactions between a given buyer and seller are available only on a protected basis at appropriate levels of authorization for the buyer, the seller and the sponsor (col. 15, lines 19-25).

Barnes, on the other, teaches the hierarchy of at least two levels (user hierarchy, col. 8, lines 29-31) in order to control purchases and prevent abuses from within the organization (col. 3, lines 19-20), wherein a first member is one associated with an organization, and a second member at the second level associated with the first member and at least one organization (Each user is preferably assigned an organization user profile which specifies a level of authorization for approval of the acquisition of goods/services from a supplier, col. 4, lines 5-8).

Art Unit: 3627

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and computer program product of Conklin, to include the hierarchy of at least two levels, as taught by Barnes, in order to control purchases and prevent abuses from within the organization (Barnes col. 3, lines 19-20).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,111,690 to Wong discloses a business-to-business web commerce system which automates to the greatest degree possible, in a unified and synergistic fashion so as to run a profitable business.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
December 6, 2004

*Michael Cuff* 12/10/04  
MICHAEL CUFF  
PRIMARY EXAMINER